

**REMARKS**

***I. Introductory Remarks and Status of the Application***

Claims 51-100 are all the claims pending in the application. All claims have received substantive examination.

In the Office Action dated September 11, 2009, the Examiner has confirmed consideration of the Information Disclosure Statement (IDS) filed on April 21, 2006. The Examiner has also accepted the drawings filed on April 21, 2006. Applicant thanks the Examiner for these actions.

Applicant has added new dependent claims 101-104. Claim 101 is based on former claim 100. Claim 102 is based on claim 80. Claims 103 and 104 are based on claim 81.

Claims 54 and 60 have been rejected under 35 U.S.C. § 112, second paragraph. Additionally, claims 51, 52, 56, 57, 59, 63, 64, 75-79, 87, 90-93, 95 and 98-100 have been rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Published Patent Application No. 2003/0206282 to Omura (hereinafter Omura). Claims 53, 55, 58, 61, 62, 65-74, 80-86, 88, 89, 94, 96 and 97 are objected to as being dependent upon a rejected base claim.

No other grounds of rejection or objection are presented. The present Amendment addresses each point of rejection and objection raised by the Examiner. Favorable reconsideration is respectfully requested.

***II. Claim Objections***

The Examiner has indicated that claims 53, 55, 58, 61, 62, 65-74, 80-86, 88, 89, 94, 96 and 97 are objected to as being dependent upon a rejected base claim, but would be allowable if

rewritten in independent form. The Examiner has further indicated that claims 54 and 60 would be allowable if rewritten in independent form, as well as amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicant has amended claim 51 to include the features of claim 53, and claims 64 and 68 have been amended into independent form. Furthermore, claims 65-67, 76-79 and 81 have been amended to depend on newly independent claim 64. Claims 69, 70, 80 and 81 have been amended to depend on newly independent claim 68. Applicant respectfully submits that all pending dependent claims now depend on currently allowable independent claims 51 and 68, or depend on independent claim 64, which Applicant submits will be shown below to be allowable.

### ***III. Claim Rejections***

#### **Claim Rejections Under 35 U.S.C. § 112, second paragraph**

Without conceding the argument in the grounds of rejection, claims 54 and 60 have been amended to better comply with U.S. practice, and to improve clarity. It is submitted that the amendments to claims 54 and 60 render moot the rejections for lack of antecedent basis.

#### **Claim Rejections Under 35 U.S.C. § 102((b))**

The grounds of rejection allege that claims 51, 52, 56, 57, 59, 63, 64, 75-79, 87, 90-93, 95 and 98-100, are anticipated by Omura. Applicant respectfully traverses the rejection for the reasons to follow.

Without conceding the arguments in the grounds of rejection, claim 51 has been amended to include the features of claim 53, and claim 53 has been cancelled accordingly. As stated in the Detailed Action, claim 53 would have been allowable if written in independent form, and

therefore Applicant respectfully submits that claim 51 is now in a state of allowance.

Furthermore, Applicant submits that claims 52, 54-63, 71-75 and 80-101 are allowable due *at least* to their dependence on claim 51.

With regards to claim 64, the grounds of rejection allege that Omura's table 11 discloses the feature of "at least one aspheric surface is arranged in each lens group." Applicant respectfully disagrees.

As currently amended, claim 64 recites (in part):

a fourth lens group directly following the third lens group and of positive refractive power;  
a fifth lens group directly following the fourth lens group and of positive refractive power; and  
a system diaphragm that is arranged in a transition region from the fourth lens group to the fifth lens group,  
wherein the fourth lens group has an entrance surface that lies in the vicinity of a point of inflection of a marginal ray height between the third lens group and the fourth lens group, and no negative lens of substantial refractive power is arranged between the entrance surface and the system diaphragm, and  
wherein at least one aspheric surface is arranged in each lens group.

As stated above, claim 64 requires that there be at least one aspheric surface arranged in each lens group. Furthermore, claim 64 requires a fourth lens group with an entrance surface that lies in the vicinity of a point of inflection of a marginal ray height between the third lens group and the fourth lens group, and a diaphragm arranged in the transition region from the fourth lens group to the fifth lens group. Finally, claim 64 requires that there be no negative lens

of substantial refractive power arranged between the entrance surface and the system diaphragm. Applicant submits that nowhere in Omura is such a system disclosed.

Assuming *arguendo* that any lens in Omura could correspond with the image side lens of the claimed fourth lens group, it would have to be Omura's lens L43. This must be the case because claim 64 requires that the diaphragm be arranged in a transition region from the fourth lens group to the fifth lens group, and in Omura, the aperture stop AS is arranged between lenses L43 and L51.

Continuing to assume *arguendo*, if any lens in Omura could correspond to the object-side lens of the claimed fourth lens group it would have to be lens L41. This must be the case because claim 64 requires that no negative lens of substantial refractive power is arranged between the entrance surface and the system diaphragm. Omura's lens L33 is a negative lens of substantial refractive power, and therefore, cannot be part of the claimed fourth lens group. (see Omura Fig. 1). Additionally, Omura's lens L33 cannot possibly be part of the claimed fourth lens group because the entrance surface of lens L33 is not in the vicinity of a point of inflection of a marginal ray height between the third lens group and the fourth lens group, as required by claim 64. Therefore, even if, *arguendo*, any group of lenses in Omura could be analogized to the claimed fourth lens group, it would have to be Omura's lenses L41, L42 and L43.

A reading of Table 1 clearly shows that no surface of lenses L41, L42, or L43 is an aspheric surface. Because no surface of L41, L42, or L43 is aspheric, Omura cannot possibly disclose "at least one aspheric surface ... arranged in each lens group," as claimed in claim 64.

Additionally, no other embodiment disclosed in Omura teaches or suggests all of the limitations as claimed in claim 64.

For *at least* these reasons, Applicant submits that claim 64 patentably distinguishes over the cited prior art. Furthermore, due *at least* to their dependence on claim 64, Applicant submits that claims 76-79 also patentably distinguish over the cited prior art.

***IV. Concluding Remarks***

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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